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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,912	06/23/2003	Richard L. Antrim	006401.00399	7581
22908	7590	08/16/2006		
BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606			EXAMINER KHARE, DEVESH	
			ART UNIT	PAPER NUMBER
			1623	

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/601,912

Applicant(s)

ANTRIM ET AL.

Examiner

Devesh Khare

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Applicant's amendments and remarks filed on 05/23/2006 are acknowledged. Claim 1 has been amended. New claim 35 has been added. Claims 11-33 have been cancelled previously.

The following is new rejection(s) necessitated by Applicant's amendment filed on 05/23/2006.

Claims 1-10, 34 and 35 are currently pending in this application.

**35 U.S.C. 112, second paragraph rejection**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

Claims 1-10, 34 and new claim 35 are rejected under the second paragraph of 35 U.S.C. 112, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention of record.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: there is no particular definition of an "extrusion reaction" in the specification. The specification at pages 9-10 (see paragraph [0025] of the PGPub) states clearly that dextrinization should be sufficient to convert at least a portion of highly digestible 1-4 bonds present in the starting material to other bonds. It is noted that there is also no clear equivalence of "dextrinization" with "extrusion reaction". The applicant failed to recite in the claim a process with reaction conditions that defines a novel product.

Claims which depend from an indefinite claim which fail to obviate the indefiniteness of the claim from which they depend are also seen to be indefinite and are also rejected for the reasons set forth supra.

### ***Response to Arguments***

Applicant's arguments traversing the rejection of claims 1-10, 34 and new claim 35 under the second paragraph of 35 U.S.C. 112 have been fully considered but they are not persuasive.

Applicants argue, " the term "extrusion reaction" is readily comprehensible in the context of the present application" and "although the examiner may not immediately be familiar with this term, one of ordinary skill in the art would have no trouble determining the meaning of this term, particularly in light of the teachings of the specification."

The presence of the term "extrusion reaction" in the specification is noted. There is no particular definition of an "extrusion reaction" in the specification. The specification at pages 9-10 (see paragraph [0025] of the PGPub) states clearly that dextrinization should be sufficient to convert at least a portion of highly digestible 1-4 bonds present in the starting material to other bonds. However, applicant's specification fail to particularly point out the definition of extrusion reaction.

### **Claim Rejections - 35 USC § 102**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1,2,7, 34 and new claim 35** are rejected under 35 U.S.C. 102(b) as being anticipated by Levine et al. (U.S. Patent 5,009,900) of record.

The applicants' claims are directed toward a saccharide-derived oligosaccharide mixture comprising: 1. a saccharide product with an average degree of polymerization of 1-4 mixed with; 2. malto-oligosaccharide when extruded after heat and work, portion of the malto-oligosaccharide derivatized with said saccharide.

Levine et al anticipates the claims as it teaches a saccharide product (col.4, lines 30-41) wherein (a) is a dextrose containing saccharide component (from starch), (b) is a maltodextrin component (equivalent to applicant's malto-oligosaccharide), (c) is polydextrose (could suffice as the saccharide component), and (d) is mono or disaccharide, such as maltose. Levine et al also discloses maltodextrins (col.4, lines 51-54) and extrusion process (col.8, lines 44-68). The mixture is then subjected to extrusion. Thus, this meets the process limitations.

Regarding new claim 35, the new limitation of how the extrusion reaction is performed does not have any patentable weight to the composition claimed in claim 1.

### ***Response to Arguments***

Applicant's arguments traversing the rejection of claims 1, 2,7,34 and 35 under 35

U.S.C 102(b) have been fully considered but they are not persuasive.

Applicants argue, "the reference does not teach derivatization in the examples, as is apparent from the extrusion temperatures provided. Nor is acid catalysis is taught." This is not found to be persuasive because:

In a composition claim there is no patentable weight is given how the individual components are produced.

Levine et al anticipates the claims as it teaches a saccharide product (col.4, lines 30-41) wherein (a) is a dextrose containing saccharide component (from starch), (b) is a maltodextrin component (equivalent to applicant's malto-oligosaccharide), (c) is polydextrose (could suffice as the saccharide component), and (d) is mono or disaccharide, such as maltose.

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07 (a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Devesh Khare whose telephone number is (571)272-0653. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anna Jiang, Supervisory Patent Examiner, Art Unit 1623 can be reached at (571)272-0627. The official fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Devesh Khare, Ph.D.,J.D.  
Art Unit 1623  
August 14, 2006

  
Anna Jiang, Ph.D.  
Supervisory Patent Examiner  
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